



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

Aw

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,246	04/06/2001	William L. Grouell	843161-85	2732
23879	7590	02/20/2004	EXAMINER	
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			CHERVINSKY, BORIS LEO	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/828,246

Applicant(s)

GROUELL, WILLIAM L.

Examiner

Boris L. Chervinsky

Art Unit

2835

AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-14,16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 4, 9 and 17 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue application is based. Claims 1, 4, 9 and 17 are omitting the limitations of the claim 8 of the original application, which was amended to include these limitations in that claim to overcome the prior art rejection. Specifically, the limitation that the plate and the fin are rectangular in shape is improperly omitted. Claims 4, 9 and 17 are omitting the limitation that the plate having two sides spaced no further apart than overall width of the hard drive. These limitations were added and argued to overcome the prior art rejection and considered to be the surrender limitations. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

### ***Response to Arguments***

2. Applicant's arguments filed 01/14/04 have been fully considered but they are not persuasive. The rejection is based on MPEP § 1412.02 -Recapture of Canceled Subject Matter and recent decision of the Court of Appeals for the Federal Circuit and two recent decisions of the Board of Patent Appeals and Interferences: *Pannu v. Storz Instruments Inc.*, 258 F. 3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished,

precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board).

The presence of recapture in this case is found by determining that the reissue claims 1, 4, 9 and 17 are broader than the patent claim since it omitted the limitation regarding the plate being of a rectangular shape when viewed in plan (claims 1, 4, 9 and 17) and “the spaced apart two sides” limitation cannot represent a broader form of key limitation which may not be rejected under recapture doctrine. The limitation that the two sides spaced no further apart than the overall width of the hard drive is omitted from claims 4, 9 and 17. The above-mentioned limitations were included in the patent claim since Applicant had argued that these limitations distinguish the claimed article over the art in obtaining the patent during the prosecution of the original application, therefore it is impermissible recapture for a reissue.

Applicant's argument regarding “Fundamental Narrowness” is not persuasive since the recapture is not always avoided by making a reissue claim narrower than the claim subject matter “canceled” from the original application in favor of more specific claim subject matter, in order to overcome an art rejection. The *Pannu* court decided that a limitation A which was added in an original application to overcome an art rejection cannot then be omitted in a reissue application and replaced by a different narrowing limitation B, which is not related to limitation A. If the omitted limitation is replaced by another limitation that is not related to the subject matter previously surrendered by Applicant, recapture exist, even though the replacement limitation is a material (narrowing) limitation, and even where the replacement limitation defines the claim(s)

Art Unit: 2835

over the prior art. See *Clement* principle 3(a). [*Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris L. Chervinsky whose telephone number is 571-272-2039. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren E. Schuberg can be reached on 571-272-2800 ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**BORIS CHERVINSKY**  
**PRIMARY EXAMINER**

*Boris L. Chervinsky*  
2/17/4